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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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09/997,790

11/30/2001

David Leigh Donoho

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GLENN PATENT GROUP
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EXAMINER

WINDER, PATRICE L

ART UNIT

PAPER NUMBER

2145

DATE MAILED: 04/21/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/997,790

Applicant(s)

DONOHO ET AL.

Examiner

Patrice Winder

Art Unit

2145

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 30 January 2006.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-45 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-45 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|---|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date <u>2-23-06; 3-23-06</u> | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION***Double Patenting***

1. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. A nonstatutory obviousness-type double patenting rejection is appropriate where the conflicting claims are not identical, but at least one examined application claim is not patentably distinct from the reference claim(s) because the examined application claim is either anticipated by, or would have been obvious over, the reference claim(s). See, e.g., *In re Berg*, 140 F.3d 1428, 46 USPQ2d 1226 (Fed. Cir. 1998); *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) or 1.321(d) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent either is shown to be commonly owned with this application, or claims an invention made as a result of activities undertaken within the scope of a joint research agreement.

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

2. Claim 38 is rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claim 30 of U.S. Patent No. 6,263,362 B1.

Although the conflicting claims are not identical, they are not patentably distinct from each other because the inclusion of another limitation is within the breath of the previously patented claim. The limitation in question is "said advise consumer maintains anonymity, privacy, and security by not revealing to said advise provider either that said advice consumer is interested in advice from said advice provider, that said advice consumer has received any particular advice, or that said advice is relevant to said advice consumer" in claim 38 of the present application.

Claim Rejections - 35 USC § 102

3. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

4. Claims 1-45 are rejected under 35 U.S.C. 102(e) as being anticipated by Hunt et al., USPN 5,893,091 (hereafter referred to Hunt).

5. Regarding claim 1, Hunt taught a method for inspecting any of the properties of a computer, said computer's configuration, contents of said computer's storage devices, said computer's peripherals, and said computer's environment (abstract), comprising the steps of:

providing at least one inspector library at said computer, said at least one inspector library at least one inspector and associated methods (column 9, lines 11-21);

sending one or more advisories from an advice provider to said computer, wherein said advisories are sent regardless of relevance to said computer (column 7, lines 53-64);

performing an inspection with said inspector at said computer, the inspection comprising any of matematico-logical calculations, executing computational algorithms,

returning results of system calls, accessing contents of storage devices, and querying devices or remote computers to inspect any of said properties, said computer's configuration, contents of said computer's storage devices, said computer's peripherals and said computer's environment (column 9, lines 41-56); and

locally determining relevance at said computer of said received advisories, said relevance based on said results of said performed inspection (column 7, line 64- column 8, line 5).

6. Regarding dependent claim 2, Hunt taught a method further comprising:
providing an inspector dispatch associated with an advice client computer for continually performing relevance determination; wherein the relevance determination is driven by a database of relevance clauses which can be continually evaluated (column 8, lines 55-64).

7. Regarding dependent claim 3, Hunt a method further comprising the steps of:
sending certain relevance clauses to a remote location; evaluating said clauses; returning said clauses after a user is made aware of what is being transferred; wherein properties of said remote location are learned (column 7, lines 56-64).

8. Regarding dependent claim 4, Hunt taught relevance evaluation is driven in a master-slave relationship by master machine which tells a slave machine to evaluate a clause (column 15, lines 4-34).

9. Regarding dependent claim 5, Hunt taught properties which can be learned are an arbitrary combination of elementary properties that are determined according to basic calculations (column 10, lines 32-53).

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10. Regarding dependent claim 6, Hunt taught said at least one inspector is built into said inspector dispatcher (column 10, lines 32-41).

11. Regarding dependent claim 7, Hunt taught the method further comprising the step of: providing one or more caches for avoiding heavy CPU and disk access overhead while successfully performing said continual relevance evaluation (column 13, lines 11-20).

12. Regarding dependent claim 8, Hunt taught an object, property name, and/or string selector is dispatched for relevance evaluation using a method dispatch module in accordance with dispatch information contained within a method dispatch table (column 11, lines 36-48).

13. Regarding dependent claim 9, Hunt taught said method dispatch module performs the steps of:

parsing a clause in relevance in a relevance language; generating a list of method dispatches in response to said parsing step, wherein specific methods are called in a specific order with specific argument list; and systematically carrying out a sequence of method dispatches in an appropriate order (column 9, lines 23-56).

14. The language of claims 10-45 is similar to previously rejected claims 1-9.

Therefore, they are rejected under Hunt for the same reasons set forth in the rejection of claims 1-9 (Supra 1-9), above.

Response to Arguments

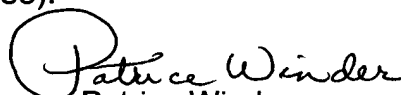
15. Applicant's arguments with respect to claims 1-45 have been considered but are moot in view of the new ground(s) of rejection.

Conclusion

16. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Patrice Winder whose telephone number is 571-272-3935. The examiner can normally be reached on Monday-Friday, 10:30 am-7:00 pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Jason Cardone can be reached on 571-272-3933. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).


Patrice Winder
Primary Examiner
Art Unit 2145

April 17, 2006